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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,684	08/27/2004	Penny Anne Wallace		2646

7590 10/05/2005
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EXAMINER

LAYNO, BENJAMIN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/783,684	Applicant(s) WALLACE ET AL.	
	Examiner Benjamin H. Layno	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled (in this case the Applicant indicated that claims 1-12 are to be canceled in the papers filed 10/26/04), the remaining claims must not be renumbered. When new claims are presented (in this case the Applicant submitted new claims 1-3 in the papers filed 10/26/04), they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). In this case new claims 1-3 should have been renumbered 13-15, respectively.

Misnumbered claims 1-3 have been renumbered 13-15.

Claim Rejections - 35 USC § 112, Claims Indefinite

2. Claims 13-15, filed 10/28/04, are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. **Note the format of the claims in the cited patents to Glennon,**

Turner et al., Dreznick et al., and Kolleth. The claims are numerically numbered at the end of these patents.

Abstract Objections

The abstract filed 08/27/04 is objected to because the sheet the abstract is printed on also contains a list below the abstract:

"Game Contents

- One Game Board
- One Die
- Six Game Pieces....."

This list is **not permitted**. There must be **no other text** on this sheet. A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text, 37 CFR 1.52(b)(4).

Specification Objections

3. The disclosure is objected to because of the following informalities: The Examiner is having a difficulty determining which is the Specification and which is the Abstract.
4. The papers filed 07/15/04 disclose a sheet with the heading "SPECIFICATIONS" with text below it. Also on this sheet is a list with the heading "Game Contents". These papers filed 07/15/04 also disclose another sheet with the heading "REVIEW AND RULES OF GAME GENERAL DESCRIPTION DEATH AND FORENSICS TRIVIA A

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Game of Knowledge.....". Below the heading are titles "Object of Game:", "Number of Players:" and "Game Includes:" with descriptive text under each title. Is this sheet also part of the specification?

5. The paper filed 08/27/04 discloses a sheet with the heading "ABSTRACT".

Below this heading is text that is identical to text on the sheet with the heading

"SPECIFICATIONS" in the papers filed 07/15/04. This is confusing, exactly which is the specification, and which is the abstract?

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

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- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

6. A substitute specification including properly written claims is required pursuant to 37 CFR 1.125(a) because of the deficiencies above. **See the format of the specification of the patents to Glennon, Turner et al., Dreznick et al., and Kolleth.** Ignore the 2 column per page format. Maintain the 1 column per page, double spacing format.

A substitute specification must **not contain new matter**. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and **a statement that the substitute specification contains no new matter must also be supplied**. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

Drawings

7. The drawings filed 07/15/04 are objected to because the drawings contain extraneous text such as the title "DEATH AND FORENSICS TRIVIA", descriptive text "Game Board", Game Question Cards", "Game Box" "Game Pieces –Part 1", "Game Pieces –Part 2", names and phone numbers of inventors, Patent #, Confirmation #, dimensions of the game board, dimensions of the cards, dimensions of the dice, dimension of the box, and descriptive text of dice and game pieces. **All this extraneous text is not permitted.** The only graphics that should appear on the drawings are:

- 1) The illustrations of the invention itself (game board, cards, dice, game pieces).
- 2) Reference numerals with lines point to and labeling the different parts of the invention.
- 3) Figure numbers (e.g. Figure 1, Figure 2, etc.) labeling each illustration.

See the drawings of the patents to Glennon, Turner et al., Dreznick et al., and Kollath.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

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number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trivial Pursuit in view of Kolleth and Glennon.

The game Trivial Pursuit discloses a trivia style board game comprising a game board, six playing pieces, a plurality of (1,000) question and answer cards, a die, and a box for holding the question and answer cards. The board comprises a plurality of differently colored squares. Each square is colored with one of six different colors

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(blue, pink, yellow, brown, green and orange), each corresponding to a category. The question and answer cards each have questions on the front side and answers on the back side. Each question and answer card has six color coded questions corresponding to the six different colored spaces. The question and answers are all factual. To play Trivial Pursuit, each player selects a playing piece, a first player rolls the die, and moves the playing piece the indicated number of spaces along the playing path of the board. When the playing piece lands on a colored space, a question and answer card is selected, and the question corresponding to the colored space landed on is read by another player. If the player answers correctly, the player continues with another roll of the dice. If the player answers incorrectly, the player's playing piece does not move, and the turn passes to the next player. When a playing piece lands on a category headquarters space, a question card is selected and the player is asked a question in that category. If the player answers correctly, that player receives a colored scoring wedge corresponding to the colored category. When a player receives all six scoring wedges, the player's playing piece moves to the hub space. At the hub, if the player correctly answer a question selected by the other players, that player wins.

The patent to Glennon discloses a trivia style board game wherein players move playing pieces Fig. 2 around a playing path 28 according to the roll of dice Fig. 3. As the playing pieces move around the playing path, the players must answer trivia questions. Every time a player passes the Start/Finish line 27, that player receives a **lap card** Fig. 5. When a player receives twenty lap cards, that player wins, column 11, lines 1-29. In view of such teaching, it would have been obvious modify the rules of

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Trivial Pursuit by changing the object of Trivial Pursuit. Instead of having to collect wedges, and having to move a playing piece to the hub and correctly answer a question at the hub, lap cards would have been incorporated in the Trivial Pursuit game. The Trivial Pursuit rules would have been changed requiring players to collect lap cards as they pass a certain space. The first player that receives a predetermined number of lap cards (e.g. 3 lap cards), would have won the game. This modification would have speeded up game play of Trivial Pursuit in order for players to end the game more quickly if the players only have a limited time to play the game.

The patent to Kolleth discloses a trivia style board game Fig. 1 wherein players move playing pieces around a playing path 12 according to the roll of dice. When a playing piece lands on a question space 15, the players must answer trivia questions on cards, 20. Kolleth's game board further includes **bonus space** (Oracle space) 45. When a playing piece lands on a bonus space, a **bonus card** (Oracle card) is selected, and the player must answer a question on the bonus card. The questions on Kolleth's bonus cards are more difficult than the questions on the regular question cards. If a question on a bonus card is answered correctly the player wins points or continues moving, column 4, lines 39-58. In view of such teaching, it would have been obvious to incorporate bonus spaces to the Trivial Pursuit playing path, and to include bonus cards to Trivial Pursuit. The questions on the bonus cards would have been more difficult than the regular Trivial Pursuit questions. This modification would have made Trivial Pursuit more challenging, and thus more exciting to play.

Concerning the claimed "Death and Forensics", the Examiner takes the position that this is simply a form of **printed matter** relating to the **theme** of the game. It is well known to a person having ordinary skill in the art that a trivia style board game may be designed to incorporate **any theme** (e.g. Star Trek, 20th Century History, Dinosaurs, Training Employees, Stock Market, etc.) in order to attract a particular consumer. The number of different themes is **limitless**. Thus, the only difference between the claimed "Death and Forensics", and "Geography" "Entertainment" "History" "Art & Leisure" "Science & Nature" "Sports & Leisure" of Trivial Pursuit, resides in the meaning and information conveyed by **printed matter**. Such differences are considered **unpatentable**, *Ex parte Breslow*, 192 USPQ 431.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Turner et al. and Dreznick et al. disclose trivia style board games wherein players move playing pieces around a playing path according to the roll of dice. When a playing piece lands on colored category question space, question card is drawn, and the player must answer trivia questions corresponding to the colored space.

Services of a Registered Patent Attorney or Agent

11. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in

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this field usually acts as a liability in affording the maximum protection for the invention disclosed. **If the Applicants still believe that their invention is novel and unobvious in view of the prior art cited and the Examiner's rejection of the claims above, the Applicants are advised to secure the services of a registered patent attorney or agent to prosecute the application**, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

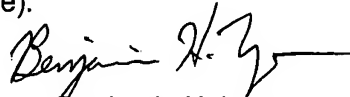
A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571)272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Benjamin H. Layno
Primary Examiner
Art Unit 3711

bhl